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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,128	01/24/2001	Brian B. Cuyler	M 6691 HST CCAE-COIL	5560

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HENKEL CORPORATION
2500 RENAISSANCE BLVD
STE 200
GULPH MILLS, PA 19406

EXAMINER

WESSMAN, ANDREW E

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 11/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/769,128

Examiner

Andrew E Wessman

Applicant(s)

CUYLER ET AL.

Art Unit

1742

-- The MAILING DATE of this communication appears in the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-5 have been cancelled, and new claims 21 and 22 have been submitted for examination. New claims 21 and 22 are independent versions of cancelled claims 4 and 5.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 21 and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Endo et al. in view of the applicant supplied translation of WO 97/45568.

Endo et al. discloses substantially the claimed invention. Endo et al. teaches (see table 1, especially examples 1-5, and claims 1 and 2) a dry in place liquid phosphating composition having 0.1 to 2.0 g/l of zinc ions, and 5 to 40 g/l of phosphate ions. Endo et al. also teaches (see table 1 and claim 1) concentrations of manganese ions from 0.1 to 3 g/l and concentrations of nickel ions from 0.1 to 6 g/l.

Endo et al. does not teach adding iron ions or hydroxylamine to a phosphating composition.

WO 97/45568 teaches (page 8, line 12 of the supplied translation) the addition of hydroxylamine to phosphating compositions because of its use as an accelerator, and teaches (see claim 1) adding hydroxylamine in an amount ranging from 0.1 to 10 g/l.

It would have been obvious to one of ordinary skill in the art to add hydroxylamine as taught by WO 97/45568 to the phosphating composition of Endo et al. because WO 97/45568 teaches that hydroxylamine is useful as an accelerator in such compositions (page 8, line 12).

In regards to the features of claim 21, the teachings of Endo et al. have been discussed above with regard to phosphate, zinc, manganese, and nickel concentrations.

Endo et al. does not teach the addition of calcium ions to a phosphating compound, nor does Endo et al. teach the addition of amino-phenolic polymers to phosphating compositions.

WO 97/45568 teaches (page 8, lines 27-30) that calcium may be added to phosphating compositions to increase hardness. WO 97/45568 also teaches (page 9, lines 10-13) adding organic polymers to phosphating compositions for the purpose of passivation, and teaches (page 9, line 25-page 10, line 9) that amino compounds of various types which can include phenolic compounds. As shown from the chemical structure on page 9, the scope of the amino compounds taught by WO 97/45568 would include compounds meeting the requirements of the claimed invention.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add calcium and an aminophenolic polymer to the phosphating compound taught by Endo et al., because one of ordinary skill in the art would expect an increase in hardness and passivation as taught by WO 97/45568 (page 9, lines 10-13).

With regards to the features of claim 22, Endo et al. does not teach the addition of an acrylic polymer to the phosphating composition.

WO 97/45568 teaches (page 13, lines 8-11) that polymers of various acrylic compounds could be used in phosphating compositions. While WO 97/45568 does not explicitly teach the specific properties of the acrylic polymers to be used in the phosphating compositions, the scope of WO 97/45568 would include such polymers that would inherently possess the properties recited in the claimed invention.

It would have been obvious to add an acrylic polymer as taught by WO 97/45568 to the phosphating composition of Endo et al., because it would be useful for surface passivation as taught by WO 97/45568 (page 9, lines 10-13).

Response to Arguments

4. Applicant's arguments filed September 11, 2002 have been fully considered but they are not persuasive. In the remarks, applicant argues:

(1) All the polymer characteristics of the claimed invention are not taught in the prior art; and

(2) There is no teaching in the prior art as to the particular usefulness of calcium.

With regards to applicant's argument (1), the disclosure of WO 97/45568 teaches polymer compositions that have structures that correspond exactly to those of the claimed invention. These polymer compositions are discussed in great detail from page 9, line 7 to page 15, line 19 of the translation and disclose numerous examples of polymers meeting the specifications of the claims. There is no suggestion in applicant's

disclosure that the polymers of WO 97/45568 are not the same as those of the claimed invention.

With regards to applicant's argument (2), applicant's own disclosure does not give any particular mention of the usefulness of calcium in the composition, and so the argument that this feature is patentably distinguishing is not convincing. WO 97/45568 does specifically (translation page 8, lines 29-30) suggest the use of calcium is phosphatizing baths, and such disclosure is sufficient to obviate the claimed invention.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew E Wessman whose telephone number is

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(703)305-3163. The examiner can normally be reached on Monday through Friday,
8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703)308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

AEW
November 13, 2002


ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700